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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,932	03/22/2004	Michael K. Brown	555255012483	1029

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Jones Day (RIM) - 2N
North Point
901 Lakeside Avenue
Cleveland, OH 44114

EXAMINER

AJAYI, JOEL

ART UNIT	PAPER NUMBER
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2617

NOTIFICATION DATE	DELIVERY MODE
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04/14/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/805,932	Applicant(s) BROWN ET AL.	
	Examiner JOEL AJAYI	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-18, 20-23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-18, 20-23, 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 17, 2010 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-12, 14-18, 20-23, 25-30 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time

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a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 5-8, 10-12, 14-18, 20-23, 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bouchard (U.S. Patent Application Number: 2003/0115448)** in view of **Picoult et al. (U.S. Patent Application Number: 2002/0065042)**, in view of **Brooks (U.S. Patent Application Number: 2004/0117456)**, and further in view of **Montville et al. (U.S. Patent Number: 6,356,937)**.

Consider **claim 1**; Bouchard discloses a method for handling secure message attachments for a mobile device, comprising the acts:

Receiving at a server (the master server sends the second attachment to the satellite server) second attachment provided within a secure message (paragraphs 56 and 58); wherein the secure message itself was received by the server as a first attachment (second encrypted email) (paragraph 62, lines 4-20); processing at the server the secure message in order to locate within the secure message the second attachment (first encrypted email) (paragraph 62, lines 4-20); and providing the second attachment to the mobile device (paragraph 63, line 1) (even though a desktop is used in this example, the client device can be a wireless device, paragraph 30, lines 1-8).

Except: requesting the second attachment from the mobile device; wherein the second attachment is automatically provided by the server to the mobile device when the secure message is opened in response to a user request.

In an analogous art, Picoult discloses requesting the second attachment (any attachments) from the mobile device (paragraph 31); wherein the second attachment is automatically provided by the server to the mobile device when the secure message is opened in response to a user request (paragraph 31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard by including the means for a mobile device to access information, as taught by Picoult, for the purpose of receiving messages with ease and flexibility.

Bouchard and Picoult disclose the claimed invention except: providing the secure message without the second attachment to the device.

In an analogous art Brooks discloses providing the secure message without the second attachment to the device (paragraphs 46 and 48, lines 1-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard and Picoult by including a secure message without an attachment as taught by Brooks for the purpose of securely transmitting attachments in a network.

Bouchard, Picoult, and Brooks disclose the claimed invention except: the attachment is automatically provided by the server to the mobile device when the secure message previously received by the mobile device is opened in response to a request at the mobile device.

In an analogous art Montville discloses that the attachment is automatically provided by the server to the mobile device when the secure message previously received by the mobile device is opened in response to a request at the mobile device [once the identity of the sender, the integrity of the message, and the fact that the sender sent it has been verified (previously received), the subscriber opens the message and automatically receives the attachment (col. 3, line 58-col. 4, line 2; col. 27, lines 12-18)].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard, Picoult, and Brooks by including previously received messages, as taught by Montville, for the purpose of providing a robust, full-featured electronic messaging system.

Consider **claim 2**; Bouchard discloses that the secure message is structured according to a security scheme such that the secure message is handled as an attachment by the server (paragraphs 56 and 58).

Consider **claim 5**; Bouchard discloses that the security scheme is a Secure Multipurpose Internet Mail Extensions (S/MIME) scheme (paragraph 58).

Consider **claim 6**; Bouchard discloses that the secure message is structured such that a secure layer has been added to the message and the second attachment (paragraphs 56 and 58).

Consider **claim 7**; Bouchard discloses that the secure layer acts as an envelope with respect to the message and the second attachment (paragraphs 56, 58, 62).

Consider **claims 8, 11**; Bouchard discloses that the secure layer was generated during an encryption operation (paragraphs 56 and 58).

Consider **claim 10**; Bouchard discloses that the secure layer was generated during a digital signature operation (paragraph 58).

Consider **claim 12**; Picoult discloses that the second attachment is selected from the group consisting of: a textual document, word processing document, audio file, image file, and video file (paragraph 25, lines 8-17; paragraph 31).

Consider **claim 14**; Picoult discloses that the request from the mobile device for the second attachment results from a user request about the second attachment (paragraph 31).

Consider **claim 15**; Brooks discloses that the request from the mobile device includes data to be used by the server to identify the second attachment that is to be provided to the mobile device (paragraphs 46 and 48, lines 1-22).

Consider **claim 16**; Bouchard discloses that the secure message is structured such that a secure layer has been added to the message and the second attachment, wherein the secure layer was generated during an encryption operation, wherein a decryption operation is performed in order to locate within the secure message the second attachment (paragraphs 45, 56, and 63).

Consider **claim 17**; Bouchard discloses that the secure message has a plurality of attachments (paragraph 56).

Consider **claim 18**; Brooks discloses that the server provides an indication to the mobile device that the secure message has the second attachment, wherein the indication is used by the mobile device to provide a user indication that the secure message has the second attachment (paragraphs 46 and 48, lines 1-22).

Consider **claims 20**; Bouchard discloses that the second attachment is rendered before being provided to the mobile device (the message is processed) (paragraph 62).

Consider **claim 21**; Bouchard discloses a means for providing a wireless network and means for providing a message server are used to communicate the located attachment to the mobile device (paragraphs 29 and 62).

Consider **claims 22, 23, 25**; Bouchard discloses that the mobile device is a handheld wireless mobile communications device (paragraph 30, lines 1-8).

Consider **claim 26**; Bouchard discloses an apparatus located at a computer server for handling secure message attachments for a mobile device, wherein the server receives a secure message containing a second attachment (paragraphs 56 and 58), comprising:

the secure message contains a secure layer such that the secure message itself is received by the server as a first attachment (second encrypted email) (paragraph 62, lines 4-20); a secure message processing module that looks into the secure message through the secure layer in order to locate the second attachment (first encrypted email) (paragraph 62, lines 4-20); wherein the second attachment is provided to the mobile device (paragraph 63, line 1) (even though a desktop is used in this example, the client device can be a wireless device, paragraph 30, lines 1-8).

Except: a data store that stores the secure message and the second attachment; wherein the second attachment is automatically provided by the server to the mobile device when the secure message is opened in response to a user request.

In an analogous art, Picoult discloses that the server stores the secure message and any attachments (paragraph 25, lines 8-17; paragraph 31); wherein the second attachment is automatically provided by the server to the mobile device when the secure message is opened in response to a user request (paragraph 31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard by including the means for a mobile device to access information, as taught by Picoult, for the purpose of receiving messages with ease and flexibility.

Bouchard and Picoult disclose the claimed invention except: providing the secure message without the second attachment to the device; after the server receives a request for the second attachment from the device.

In an analogous art Brooks discloses providing the secure message without the second attachment to the device (paragraphs 46 and 48, lines 1-22); after the server receives a request for the second attachment from the device (paragraphs 46 and 48, lines 1-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard and Picoult by including a secure message without an attachment as taught by Brooks for the purpose of securely transmitting attachments in a network.

Bouchard, Picoult, and Brooks disclose the claimed invention except: the attachment is automatically provided by the server to the mobile device when the secure message previously received by the mobile device is opened in response to a request at the mobile device.

In an analogous art Montville discloses that the attachment is automatically provided by the server to the mobile device when the secure message previously received by the mobile device is opened in response to a request at the mobile device [once the identity of the sender, the integrity of the message, and the fact that the sender sent it has been verified (previously

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received), the subscriber opens the message and automatically receives the attachment (col. 3, line 58-col. 4, line 2; col. 27, lines 12-18)].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard, Picoult, and Brooks by including previously received messages, as taught by Montville, for the purpose of providing a robust, full-featured electronic messaging system.

Consider **claim 27**; Bouchard discloses rendering the second attachment before the second attachment is provided to the mobile device (paragraph 62).

Consider **claim 28**; Bouchard discloses a decryption processing module to decrypt the secure message so that the second attachment can be located within the secure message (paragraph 62).

Consider **claim 29**; Bouchard discloses an apparatus located at a computer server for handling secure message attachments for a mobile device, comprising:

means for receiving a second attachment (first encrypted email) provided with a secure message (paragraphs 56, 58, 62, lines 4-20); wherein the secure message itself was received by the server (satellite server) as a first attachment (second encrypted email) (paragraph 62, lines 4-20); means for processing (decrypt and extract) the secure message in order to locate within the secure message the second attachment (paragraph 62, lines 4-20); means for providing the second attachment to the mobile device (paragraph 63, line 1) (even though a desktop is used in this example, the client device can be a wireless device, paragraph 30, lines 1-8).

Except: the second attachment is automatically provided by the server to the mobile device when the secure message is opened in response to a user request.

In an analogous art, Picoult discloses that the second attachment is automatically provided by the server to the mobile device when the secure message is opened in response to a user request (paragraph 31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard by including the means for a mobile device to access information, as taught by Picoult, for the purpose of receiving messages with ease and flexibility.

Bouchard and Picoult disclose the claimed invention except: providing the secure message without the second attachment to the device; receiving a request for the second attachment from the device.

In an analogous art Brooks discloses providing the secure message without the second attachment to the device (paragraphs 46 and 48, lines 1-22); receiving a request for the second attachment from the device (paragraphs 46 and 48, lines 1-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard and Picoult by including a secure message without an attachment as taught by Brooks for the purpose of securely transmitting attachments in a network.

Bouchard, Picoult, and Brooks disclose the claimed invention except: the attachment is automatically provided by the server to the mobile device when the secure message previously received by the mobile device is opened in response to a request at the mobile device.

In an analogous art Montville discloses that the attachment is automatically provided by the server to the mobile device when the secure message previously received by the mobile

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device is opened in response to a request at the mobile device [once the identity of the sender, the integrity of the message, and the fact that the sender sent it has been verified (previously received), the subscriber opens the message and automatically receives the attachment (col. 3, line 58-col. 4, line 2; col. 27, lines 12-18)].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard, Picoult, and Brooks by including previously received messages, as taught by Montville, for the purpose of providing a robust, full-featured electronic messaging system.

Consider **claim 30**; Bouchard discloses rendering the second attachment before the second attachment is provided to the mobile device (paragraph 62); a decryption processing module to decrypt the secure message so that the second attachment can be located within the secure message (paragraph 62).

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bouchard (U.S. Patent Application Number: 2003/0115448)** in view of **Picoult et al. (U.S. Patent Application Number: 2002/0065042)**, in view of **Brooks (U.S. Patent Application Number: 2004/0117456)**, and further in view of **Kiessling et al. (U.S. Patent Number: 6,795,924)**.

Consider **claims 3 and 4**; Bouchard and Picoult disclose the claimed invention except that the security scheme includes a symmetric and asymmetric key scheme.

In an analogous art, Kiessling discloses that the security scheme includes a symmetric and asymmetric key scheme (column 2, lines 12-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard and Picoult by including symmetric and asymmetric methods, as taught by Kiessling, for the purpose of providing secure messages to mobile terminals.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Bouchard (U.S. Patent Application Number: 2003/0115448)** in view of **Picoult et al. (U.S. Patent Application Number: 2002/0065042)**, in view of **Brooks (U.S. Patent Application Number: 2004/0117456)**, and further in view of **Fan et al. (U.S. Patent Application Number: 2003/0031320)**.

Consider **claim 9**; Bouchard discloses that a secure message has been sent from an email sender (par. 52) for routing (par. 56 and 62, lines 4-20) to the mobile device (par. 29, lines 4-6; par. 30, lines 1-8). Bouchard, Picoult, and Brooks disclose the claimed invention except: a session key is received by the server from the mobile device for use by the server to decrypt the secure message.

In an analogous art Fan discloses that a session key is received by the server (110) from the mobile device (102) (par. 36) for use by the server to decrypt the secure message (sent from a client (112)) (par. 19 and 74).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Bouchard, Picoult, and Brooks by including a session key for use to decrypt secure messages as taught by Fan for the purpose of ensuring communications between a wireless device and a server are encrypted.

Conclusion

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

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401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Joel Ajayi whose telephone number is (571) 270-1091. The Examiner can normally be reached on Monday-Friday from 7:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

/Joel Ajayi/

Examiner, Art Unit 2617